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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Stephen P. CRAIG

Conf. No. 5281

App. No.: 10/649,614

Group: 3644

Filed: August 28, 2003

Examiner: Susan C. Alimenti

For: BARRIER ARRANGEMENT FOR PLANTS

**PETITION TO THE COMMISSIONER FOR REFUND OF FEES**

**Mail Stop Petition**

January , 2006

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

Applicant respectfully petitions the Commissioner for the refund of certain fees. The uncontroverted facts of this case are as follows.

In the Office Action of March 4, 2004, claims were rejected under 35 U.S.C. § 112, as well as being unpatentable under 35 U.S.C. § 103(a) over the U.S. Patent 3,766,667 to Glassman.

In the Amendment of June 8, 2004, most of the claims were left unamended, and the rejection over the prior art was discussed at length in the Remarks of this Amendment.

In the next Office Action of July 27, 2004, which was made Final, claims continued to be rejected under 35 U.S.C. § 103(a) as unpatentable over the same Glassman patent.

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At the personal interview on September 22, 2004, with the Primary Examiner Jeffrey L. Gellner, the undersigned again pointed out the inadequacies of the reference and begged the Examiner to reopen the case by making another search, also indicating that he would have no alternative but to proceed by appeal as acknowledged in the Interview Summary. The undersigned was an Examiner in the PTO from 1946 until 1950 and based on his training at that time and on the experience gained in private practice since, was convinced of the fatal shortcomings of the references to support the rejections on prior art. However, his pleas for another search were denied by the Primary Examiner, who insisted that the rejections were proper and that there was no need for a further search.

An Amendment under 37 C.F.R. § 1.116 was filed subsequent to the interview in which formal matters were corrected, and the rejections were again argued, in particular also the prior art rejection over the Glassman patent ('667), summarizing the arguments also presented at the interview.

Faced with what appeared to be a clearly erroneous rejection based on inadequate support in the prior art, applicant had no choice but to file Notice of Appeal on October 20, 2004, with the required Notice of Appeal Fee in the amount of \$170.00 and with the required fee for the Oral Hearing in the amount of \$150.00.

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An Appeal Brief reiterating the arguments of inadequacy of the prior art rejections was submitted in due course.

However, in lieu of an Examiner's Answer, another Office Action was issued on June 2, 2005, rejecting the claims under 35 U.S.C. § 103(a) over two newly found patents, apparently the result of a further search. The re-opening of the prosecution subsequent to the submittal of an Appeal Brief is an unusual procedure which is particularly egregious in the instant case because of the strong urging at the personal interview that a further search be made. It is also noted that the Appeal Brief basically utilized the same arguments of the inadequacies of the prior art rejections as presented in prior amendments and especially also at the time of the personal interview.

An Amendment was filed on August 29, 2005, in response to the new grounds of prior art rejections, pointing out that the newly discovered prior art was again woefully inadequate to support the rejections.

Next, the undersigned was informed that the case would be allowed with some minor amendment. This amendment, however, in no way changes the scope of the claims, does not render the same more definite and was not suggested in response to any rejection or objection and therefore is at best only a "face-saving" amendment.

The Petition for Refund is based on the Examiner's unwillingness to make a further search as strongly urged at a personal interview,

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forcing applicant to proceed by appeal by paying \$320.00 in fees and submitting an Appeal Brief, only to have the appeal procedure thwarted **ab initio** by the reopening of the prosecution after an apparent new search.

The subsequent examining procedure clearly points out that the newly discovered references did not justify reopening of the case.

The payment of the Notice of Appeal Fee and of the Oral Hearing Fee without the slightest **quid pro quo** by the PTO mandates the refund of these fees because they were completely unnecessarily paid, as clearly shown by the prosecution in this case. It is thereby of no import whether the theory of refund be grounded on unjust enrichment, failure of due process or abuse of discretion or simply for reasons of principles of fairness.


Accordingly, it is respectfully requested that the fees in the amount of \$320.00 be refunded to the Deposit Account of Paul M. Craig, Jr., Account No. 03-3560, to avoid the need for any possible further action. Though it is believed that no Petition fee is due in view of the above-noted circumstances, it is respectfully requested that any shortage of

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Fees be charged to the Deposit Account of Paul M. Craig, Jr., Account No.  
03-3560.

Respectfully submitted,

PMC/mks

  
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**CERTIFICATE OF MAILING**

I hereby certify that this correspondence, Petition for Refund of  
Fees, is being deposited with the United States Postal Service, as First  
Class Mail, postage prepaid, in an envelope addressed to

**MAIL STOP PETITION**  
Commissioner for Patents  
P. O. Box 1450  
Alexandria, Virginia 22313-1450

on January 12<sup>th</sup>, 2006.

  
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Paul M. Craig, Jr.

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APPEAL BRIEF - PATENTS  
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IN THE U.S. PATENT AND TRADEMARK OFFICE

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App. No.: 10/649,614                              Group: 3644  
Filed: August 28, 2003                              Examiner: Susan C. Alimenti  
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**APPEAL BRIEF**

**MAIL STOP APPEAL  
BRIEF - PATENTS**

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**INTRODUCTION**

Pursuant to 37 C.F.R. § 1.192, this Appeal Brief is filed in support of the Notice of Appeal to the Board of Patent Appeals and Interferences dated October 20, 2004, appealing the rejection of the claims as set forth in the Final Office Action of July 27, 2004, as modified in the Advisory Action dated October 7, 2004.

**REAL PARTY IN INTEREST**

The real party interest is Stephen P. Craig, the inventor named in the application.

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Adjustment date: 02/17/2006 EEKUBAY1  
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